

Remarks

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks. Upon entry of this amendment, claims 4-7, and 13-21 remain in the application.

Formal Request For Interview

Upon reviewing this response, if any issues remain, the Examiner is formally requested to contact the undersigned prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicants submit the foregoing formal Response so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more focused. This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

Initialed Form 1449's

Applicant thanks the Examiner for providing initialed Form 1449's for various Information Disclosure Statements filed in the application.

To date, Applicant has not received an initialed Form 1449 for the following:

(1) Page 1 (of 1) of the Form 1449 for the IDS filed August 19, 2005, (received by the USPTO on August 22, 2005), which lists, among other things, a patent reference to Dan et al.

Applicant is including a copy of the IDS and the 1449 with the Reply, and respectfully request that the Examiner consider the cited references.

Claim Rejections Under 35 USC § 103(a)

The Office asserts that claims 6, 4, 5, 20, and 21 are unpatentable over Herz in view of Yoshinobu, U.S. Patent No. 5,734,444 ("Yoshinobu") and further in view of Alexander, U.S. Patent No. 6,177,931 ("Alexander"). The Office asserts a rejection of claims 7, and 14-18 as obvious over Herz and Yoshinobu, in view of Alexander, and in further view of Lazarus, U.S. Patent No. 5,652,613 ("Lazarus"). The Office asserts a rejection of claim 19 as obvious over Herz, Yoshinobu, and Alexander, in view of Lazarus, and further in view of Daniels, U.S. Patent Publication No. 2002/0032907 ("Daniels").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP § 2142.)

Motivations to combine or modify references must come from the references themselves or be within the body of knowledge in the art. (See MPEP § 2143.01.)

Claim 6

Claim 6, as amended, recites as follows:

A method of operating a video system, the system including a video input, a controller, and a store, the method comprising:

- monitoring a user's viewing habits to determine a favorite broadcast video program;
- copying the video program to the store if the user is not viewing said program when broadcast wherein the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast;
- defining plural viewing channels;
- on certain of said channels, presenting television programs for viewing;
- on at least one of said channels, presenting said copied video program for viewing;
- maintaining the copied video program after viewing;
- generating profiles for plural users, said profiles comprising user viewing habits and at least two other user features comprising a game habit, a chat habit, zip code, an interactive news habit, or a jukebox habit;
- suggesting a specific program to a viewer, based upon similar preferences determined from said profiles;
- monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and
- copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

Applicants have amended claim 6 to include language from claim 3. Hence, the rejection for claim 3 will be argued here. Applicants respectfully assert that the proposed Herz-Yoshinobu-Alexander-Hendricks combination, at a minimum, fails to teach or suggest "monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by

the user when broadcast, in accordance with said ranking.”

The Examiner indicates that “Herz, Yoshinobu, and Alexander fail to disclose monitoring the user’s viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.” Applicants agree. Applicants disagree, however, with the Examiner’s statement that Hendricks teaches or suggests the above claim language.

The Office Action asserts that the following language in Hendricks describes *copying to the store plural programs that are not viewed by the user when broadcast*:

“In so doing, this sorting subroutine determines and ranks those programs and program categories that are most frequently viewed by that set top terminal 220.” Hendricks, col. 38, lines 56-61.

“All rankings of programs and program categories for that set top terminal 220 are written to the Viewer Profile database 314, updating the Viewer Log File, as at function block 502.” Hendricks, col. 39, lines 3-6.

Applicants respectfully assert that the language quoted above fails to teach or suggest, at a minimum, “*copying to the store plural programs that are not viewed by the user when broadcast*.” For example, Hendricks does not teach or suggest “copying to the store plural programs.” In Hendricks, “rankings of programs”, not the programs themselves, are written to a database, which then updates a viewer log file. Hendricks, col. 38, lines 56-57. There is no mention of the programs themselves being saved.

Hendricks also does not teach or suggest “*programs that are not viewed by the user when broadcast*.” Hendricks makes no mention of programs that a viewer has not watched. Hendricks does mention that the “most frequently viewed programs” are determined and ranked. However, determining which programs are “most frequently viewed” tells nothing about which programs are not viewed at all. As there is no determination of which programs are not viewed by the user when broadcast, and there is no copying of any programs at all, let alone copying programs that are not viewed by the user when broadcast, Hendricks cannot teach or suggest “*copying to the store plural programs that are not viewed by the user when broadcast*.”

For at least this reason, amended claim 6 is allowable. Such action is respectfully requested.

Claims 20-21

Claims 20 and 21 depend from claim 6. In the interest of brevity, Applicant does not belabor

the language of each of the dependent claims, but points out that they recite novel and nonobvious features allowable over Herz-Yoshinobu-Alexander-Hendricks. Since they depend from an allowable claim, they should be allowed for at least the reasons stated for claim 6. In view of the foregoing discussion of claim 6, the merits of the separate patentability of dependent claims 20 and 21 are not belabored at this time. Claims 20, and 21 should be allowable. Such action is respectfully requested.

Claim 7

Claim 7, as amended, recites as follows:

A method of operating a video system, the system including a video input, a controller, and a store, the method comprising:
monitoring a user's viewing habits to determine a favorite broadcast video program;
copying the video program to the store if the user is not viewing said program when broadcast wherein the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast; ~~and~~
defining plural viewing channels;
on certain of said channels, presenting television programs for viewing;
on a designated channel, presenting said copied video program for viewing;
wherein as space is needed, said copied video programs are overwritten in the following priority, first overwrite viewed copied video programs, then overwrite non-viewed copied video programs;
monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and
copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

Applicants respectfully assert that the proposed Herz-Yoshinobu-Alexander-Lazarus-Hendricks combination, at a minimum, fails to teach or suggest "monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking."

The Examiner indicates that "Herz, Yoshinobu, and Alexander fail to disclose monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking." Applicants agree. Applicants disagree, however, with the Examiner's statement that Hendricks teaches or suggests the above claim language.

The Office Action asserts that the following language in Hendricks describes *copying to the store plural programs that are not viewed by the user when broadcast*:

“In so doing, this sorting subroutine determines and ranks those programs and program categories that are most frequently viewed by that set top terminal 220.” Hendricks, col. 38, lines 56-61.

“All rankings of programs and program categories for that set top terminal 220 are written to the Viewer Profile database 314, updating the Viewer Log File, as at function block 502.” Hendricks, col. 39, lines 3-6.

Applicants respectfully assert that the language quoted above fails to teach or suggest, at a minimum, “*copying to the store plural programs that are not viewed by the user when broadcast*.” For example, Hendricks does not teach or suggest “copying to the store plural programs.” In Hendricks, “rankings of programs”, not the programs themselves, are written to a database, which then updates a viewer log file. Hendricks, col. 38, lines 56-57. There is no mention of the programs themselves being saved to a database.

Hendricks also does not teach or suggest “*programs that are not viewed by the user when broadcast*.” Hendricks makes no mention of programs that a viewer has not watched. Hendricks does mention that the “most frequently viewed programs” are determined and ranked. However, determining which programs are “most frequently viewed” tells nothing about which programs are not viewed at all. As there is no determination of which programs are not viewed by the user when broadcast, and there is no copying of any programs at all, let alone copying programs that are not viewed by the user when broadcast, Hendricks cannot teach or suggest “*copying to the store plural programs that are not viewed by the user when broadcast*.”

For at least this reason, amended claim 7 is allowable. Such action is respectfully requested.

Claim 14

Amended claim 14 reads as follows:

A computer readable medium including executable instructions that cause a digital processor to perform a method, the executable instructions comprising:
instructions for monitoring a user’s viewing habits to determine a favorite video program;
instructions for copying the favorite video program to memory if the user is not viewing said program when broadcast wherein the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast;

instructions for defining plural viewing channels;
instructions for overwriting copied video programs in a following priority, first
overwrite viewed copied video programs, then overwrite non-viewed copied video
programs;
*instructions for monitoring the user's viewing habits to determine a ranking of
viewed broadcast video programs by viewing frequency; and*
*instructions for copying to a storage medium plural programs that are not
viewed by the user when broadcast, in accordance with said ranking.*

Applicants respectfully assert that the proposed Herz-Yoshinobu-Alexander-Lazarus-Hendricks combination, at a minimum, fails to teach or suggest “monitoring the user’s viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.”

The Examiner indicates that “Herz, Yoshinobu, and Alexander fail to disclose monitoring the user’s viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.” Applicants agree. Applicants disagree, however, with the Examiner’s statement that Hendricks teaches or suggests the above claim language.

The Office Action asserts that the following language in Hendricks describes *copying to the store plural programs that are not viewed by the user when broadcast*:

“In so doing, this sorting subroutine determines and ranks those programs and program categories that are most frequently viewed by that set top terminal 220.” Hendricks, col. 38, lines 56-61.

“All rankings of programs and program categories for that set top terminal 220 are written to the Viewer Profile database 314, updating the Viewer Log File, as at function block 502.” Hendricks, col. 39, lines 3-6.

Applicants respectfully assert that the language quoted above fails to teach or suggest, at a minimum, “*copying to the store plural programs that are not viewed by the user when broadcast.*” For example, Hendricks does not teach or suggest “copying to the store plural programs.” In Hendricks, “*rankings of programs*”, not the programs themselves, are written to a database, which then updates a viewer log file. Hendricks, col. 38, lines 56-57. There is no mention of the programs themselves being saved to a database.

Hendricks also does not teach or suggest “*programs that are not viewed by the user when*

broadcast.” Hendricks makes no mention of programs that a viewer has not watched. Hendricks does mention that the “most frequently viewed programs” are determined and ranked. However, determining which programs are “most frequently viewed” tells nothing about which programs are not viewed at all. As there is no determination of which programs are not viewed by the user when broadcast, and there is no copying of any programs at all, let alone copying programs that are not viewed by the user when broadcast, Hendricks cannot teach or suggest “*copying to the store plural programs that are not viewed by the user when broadcast.*”

For at least this reason, amended claim 14 is allowable. Such action is respectfully requested.

Claims 15-18

Additionally, claims 15-18 depend from claim 14. In the interest of brevity, Applicant does not belabor the language of each of the dependent claims, but points out that they recite novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander-Lazarus-Hendricks combination. Further, since they depend from claim 14, they should be allowed for at least the reasons stated for claim 14. Claims 15-18 should be allowable. Such action is respectfully requested.

Claim 19

The Office asserts a rejection of claim 19 as obvious over Herz, Yoshinobu, and Alexander, in view of Lazarus, and further in view of Daniels, U.S. Patent Publication No. 2002/0032907 (“Daniels”). Applicants respectfully assert that claim 19 recites novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander-Lazarus-Daniels-Hendricks combination. Further, since it depends from allowable claim 14, it should be allowed for at least the reasons stated for claim 14. Claim 19 should be allowable. Such action is respectfully requested.

Claim Rejections Under 35 USC § 102(e)

The Office asserts that claim 13 is anticipated over Herz, U.S. Patent No. 5,758,257 (“Herz”).

Claim 13

Applicants respectfully submit the claims in their present form are allowable over the cited art. For a 102(e) rejection to be proper, the cited art must show each and every element as set forth in a claim. (*See*, MPEP § 2131.01) However, the cited art fails to do so.

Amended claim 13 recites as follows:

A method of operating a computer implemented interactive entertainment system

comprising:

receiving a composite signal comprising plural channels modulated onto separate carrier frequencies;

on certain of said channels, receiving television programs;

on at least one of said channels, receiving video on demand movies;

on at least one of said channels, receiving HTML-based content, comprising at least one of a game channel, an interactive news channel, or a jukebox channel;

logging entertainment selections of plural users;

generating affinity groupings based on at least three of: similarities in the movie selections logged, tv selections logged, games played, chat habits, interactive news habits, or jukebox habits;

logging entertainment selections of a first user to create a first user profile, the entertainment selections comprising at least one television program watched, at least one video on demand movies received, and at least one HTML-based content channel program received;

determining an affinity grouping similar to the first user's first user profile; and

presenting the first user a listing of available programs favored by members of the determined affinity grouping;

wherein upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping.

The applicants have amended claim 13 to include the following language:

receiving a composite signal comprising plural channels modulated onto separate carrier frequencies;

on certain of said channels, receiving television programs;

on at least one of said channels, receiving video on demand movies;

on at least one of said channels, receiving HTML-based content, comprising at least one of a game channel, an interactive news channel, or a jukebox channel;

Support for this amendment can be found in the specification, for example, at page 3, line 16 to page 4, line 9.

The applicants have also amended claim 13 to include the following language:

..., the entertainment selections comprising at least one television program watched, at least one video on demand movies received, and at least one HTML-based content channel program received;

Support for this amendment can be found, for example, in the specification at page 16, lines 20-23.

Applicants respectfully assert that Herz fails to teach or suggest, at least, the amended language of claim 13 "*on at least one of said channels, receiving HTML-based content,*

comprising at least one of a game channel, an interactive news channel, or a jukebox channel”
and the language *“the entertainment selections comprising at least one television program watched, at least one video on demand movies received, and at least one HTML-based content channel program received.”*

Applicants also respectfully assert that Herz fails to teach or suggest, at least, the amended language of claim 13 *“generating affinity groupings based on at least three of: similarities in the movie selections logged, tv selections logged, games played, chat habits, interactive news habits, or jukebox habits.”*

Herz does state:

[T]he present invention may be used to selectively provide other materials such as news, video games, software, music, books and the like to customers based upon the profiles of those customers. The present invention also may be modified for use in an interactive system to anticipate what customers are likely to request so that the information may be downloaded in advance....”

Herz does discuss selectively providing “other materials” to users. However, Herz does not discuss how such material may be provided. For example, Herz does mention providing “news” to a user, but does not specify what type of news will be provided or how the news will be provided. Nor does Herz discuss, for example, logging games played, chat habits, interactive news habits, or jukebox habits. Herz also discusses “profiles” of customers; however one of ordinary skill in the art could not be expected to surmise the claimed arrangement of *“generating affinity groupings based on at least three of: similarities in the movie selections logged, tv selections logged, games played, chat habits, interactive news habits, or jukebox habits”* from the mere mention of providing information to a customer based upon a profile.

For at least this reason, the rejection is improper, and amended claim 13 is allowable. Such action is respectfully requested.

Claim 4, 5

Amended claims 4 and 5 depend from claim 13. Since they depend from claim 13, they should be allowed, at least, for at least the reasons stated for claim 13. In view of the foregoing discussion of claim 13, the merits of the separate patentability of dependent claims 4-5 are not further belabored at this time. Claims 4 and 5 should be allowable.

Separately, claims 4-5 recite novel and nonobvious features allowable over Herz-Yoshinobu-

Alexander-Hendricks. As such, they should be allowable. Such action is respectfully requested.

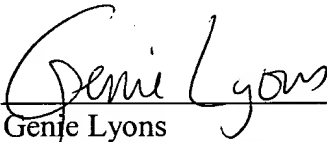
Conclusion

The claims in their present form should now be allowable. Such action is respectfully requested. The Office is respectfully reminded of the above "Formal Interview Request." The request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By 
Genie Lyons
Registration No. 43,841